

Remarks/Arguments**I. Response to Rejections under 35 USC § 102**

At pages 2-4 of the Office Action, claims 1, 6-20, 22, 23, and 25-34 are rejected under 35 USC§103(a) as being unpatentable over "Ferrel" (US Patent 5,860,073) in view of "Park" (US Patent 5,717,974). The Applicant respectfully traverses the rejection since the combination of the references does not disclose the claimed invention. Further, the Examiner is using hindsight to reconstruct the claimed invention.

In Ferrel, a style sheet (that is, a collection of formatting information, such as font and tabs in a textual document) for a publishing system is provided. However, as noted by the Examiner, Ferrel does not disclose initiating the delivery of a product subsidy when the user has printed a predetermined number of publications.

In Park, a method for monitoring prescribed use periods of replaceable parts within an image forming apparatus is disclosed. In Park, when the number of printed sheets is greater than a predetermined number, a message is displayed indicating that a corresponding one of the replaceable parts within the image forming apparatus should be replaced or cleaned. However, nowhere within Park is there any mention of a product subsidy being provided.

At page 3 of the Office Action, the Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ferrel to initiate delivery of a product subsidy when the user has printed a predetermined number of publications." The Applicant respectfully asserts that when combined, the combination of Ferrel and Park is missing the "product subsidy limitation of the claimed invention. To make a *prima facie* showing of obviousness, all of the claimed elements of an Applicant's invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no *prima facie* case of obviousness exists. The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988).

The Examiner's motivation to combine, at page 3 lines 6-7 of the Office Action, is that the combination would "ensure high quality printing". However, the examiner provides no insight into why one would expect that providing a product subsidy would have any bearing on print quality. Further, even if the Examiner were to establish a connection between print quality and a providing a product subsidy, the Examiner has provided no rationale as to why one would choose providing a product subsidy over a myriad of other techniques that might also ensure high quality printing.

The Examiner is reminded that a combination of references "combined in a manner that reconstructs the applicant's invention only with the benefit of hindsight...is insufficient to present a *prima facie* case of obviousness." There must be some reason, suggestion, or motivation found in the references whereby a person of ordinary skill in the field of the invention would make the combination. **That knowledge cannot come from the applicant's invention itself.** In re Oetiker, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) [emphasis added].

Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection to the claims and pass this Application onto allowance.

II. Additional Fees:

It is not believed that additional fees are due at this time; however, if any additional fee is required in connection with the filing of this Amendment, please charge the fee to Deposit Account No. 08-2025.

Respectfully Submitted,
Shane A. Bryan et al.

By: 
Jeff D. Limon
Agent for the Applicants
Registration Number 45,418

Hewlett-Packard Company
Legal Department
1000 NE Circle Blvd.
Corvallis, OR 97330
Telephone: (541) 715-5979
Fax: (541) 715-8581